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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,830	08/30/2001	Johannes Wilhelmus Maria Sonnemans	ACH2823US	9198

7590 02/13/2003

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EXAMINER	
NGUYEN, TAM M	

ART UNIT	PAPER NUMBER
1764	6

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary	Application No.	Applicant(s)	
	09/942,830	SONNEMANS ET AL.	
	Examiner	Art Unit	
	Tam M. Nguyen	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 16 and 17 of copending Application No. 09/829,624. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process presently claimed process uses a catalyst which is the same as the catalyst use in of the claimed process of copending application. The claimed process of copending application does not disclose the characteristics of the feedstock and an amount of the sulfur content in the product stream. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of claims 1, 16 and 16 by using the presently claimed feedstock because one of skill in the art would utilize any hydrocarbon feedstock including the claimed feedstock and because of the similarities between the present claimed process and the copending claimed process in terms of catalyst and operating conditions, it would be expected that the product stream of the

copending claimed process would contain the amount of sulfur as claimed in the present claimed process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 17 and 18 of copending Application No. 09/829,640. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process presently claimed process uses a catalyst which is the same as the catalyst use in of the claimed process of copending application. The claimed process of copending application does not disclose the characteristics of the feedstock and an amount of the sulfur content in the product stream. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of claims 1, 17 and 18 by using the present claimed feedstock because one of skill in the art would utilize any hydrocarbon feedstock including the claimed feedstock and because of the similarities between the present claimed process and the copending claimed process in terms of catalyst and operating conditions, it would be expected that the product stream of the copending claimed process would contain the amount of sulfur as claimed in the present claimed process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 32 and 33 of copending Application No. 09/829,625. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the process presently claimed process uses a catalyst which is the same as the catalyst use in of the claimed process of copending application. The claimed process of copending application does not disclose the characteristics of the feedstock and an amount of the sulfur content in the product stream. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of claims 1, 32 and 33 by using the present claimed feedstock because one of skill in the art would utilize any hydrocarbon feedstock including the claimed feedstock and because of the similarities between the present claimed process and the copending claimed process in terms of catalyst and operating conditions, it would be expected that the product stream of the copending claimed process would contain the amount of sulfur as claimed in the present claimed process.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is unclear what happens when the hydrocarbon feedstock is contacted with the catalyst.

Claim 2 recites the limitation "the product" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 is indefinite because it is unclear what happens when the hydrocarbon feedstock is contacted with the catalyst.

Claim 13 recites the limitation "the product" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerritsen et al. (EP-0870817 A1) in view of either Takahashi et al. (4,845,068), Takahashi (EP-0357295 A2), or Takahashi (EP-289211 A1).

Gerritsen discloses a hydrodesulfurization process by contacting a hydrocarbon feedstock with a catalyst in one or two reaction zones. The Gerritsen feedstock is the same as the claimed feedstock and the reactions zones are operated at conditions similar to the claimed operating conditions. (See page 4, lines 2-42)

Gerritsen does not disclose that the catalyst comprises sulfur-containing organic additive. However, Takahashi (all three references) disclose a hydrodesulfurization process wherein the process is employed a catalyst comprising metals of group VIB, VIII, and mercaptocarboxylic acids (See abstracts of all three references). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of

Gerritsen by using the catalyst of Takahashi because the catalyst of Takahashi is effective in a hydrodesulfurization process. It is noted that all the references do not disclose the amount of sulfur in the product stream. However, the similarities of the modified process of Gerritsen and the claimed process in terms of catalyst, feedstock, and operation conditions. Therefore, it would be expected that the product stream would contain the amount of sulfur as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (703) 305-7715. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Tam M. Nguyen
Examiner
Art Unit 1764

Tam Nguyen/ TN
February 8, 2003

Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700